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7590 03/31/2004	EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No. 09/802,447	Applicant(s) MICHAEL RISHEL
Office Action Summary	Examiner Etienne P LeRoux	Art Unit 2171

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 February 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>09 March 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No

6,460,060 issued to Maddalozzo et al (hereafter Maddalozzo '060).

Claims 1 and 19:

Maddalozzo '060 discloses:

- a computer [Fig 1, item 102]

- a memory [Fig 1, item 106] operable to store a single reference to a web page [col 5, lines

  2-8]

- a browser [Fig 2, item 202 and col 4, lines 7-16] coupled to the memory and operable to

  execute on the computer,

- the browser comprising a first button [search button, Fig 5, item 514] and a second button

  [next/previous buttons, Fig 5, item 502]

- wherein the browser, responsive to activation of the first button, stores a reference to a

  currently accessed web page in the memory [col 5, lines 2-8],

- wherein the browser, responsive to activation of the second button, accesses a web page

  referenced by the reference stored in the memory [col 7, lines 8-14]

Claim 2:

Maddalozzo '060 discloses wherein the reference is a URL [col 7, lines 8-14].

Claim 3:

Maddalozzo '060 discloses wherein the reference is a string identifying a web page, the

string being used to access the web page [col 7, lines 8-14].

Claim 4:

Maddalozzo '060 discloses wherein the memory is reset to a default reference each time

the browser is started [Fig 3A and col 4, lines 45-60].

Claim 5:

Maddalozzo '060 discloses wherein the default reference being a reference to a home

page [col 4, lines 17-23].

Claim 6:

Maddalozzo '060 discloses:

- providing a memory location operable to store a reference to electronic content [Fig 1,

  item 106 and col 5, lines 2-8];

- providing a user interface operably coupled to the memory location, the user interface

  comprising a first button [search button, Fig 5, item 514] and a second button

  [next/previous button, Fig 5, item 502],

- the user interface operable to display electronic content [Fig 5, item 500, col 7, lines 9-

  15];

- displaying a first electronic content in the user interface; the first electronic content

  located at a first reference [Fig 5, item 500, col 7, lines 9-15];

- storing the first reference in the memory location in response to activation of the first

    button [col 5, lines 2-8];

- displaying a second electronic content in the user interface, the second electronic content

    located at a second reference [col 5, lines 9-25]; and

- displaying the first electronic content reference by the first reference stored in the

    memory location in response to activation of the second button [col 7, lines 9-15].

Claim 7:

Maddalozzo '060 discloses further comprising storing a third reference to a third

electronic content in the memory location in response to activation of the first button, wherein

the third electronic content being currently displayed in the user interface [Fig 3A and col 4,

lines 45-49].

Claim 8:

Maddalozzo '060 discloses wherein the reference comprises a URL [col 7, lines 8-14].

Claim 9:

Maddalozzo '060 discloses wherein the reference comprises an address to electronic

content [col 5, lines 2-8].

Claim 10:

Maddalozzo '060 discloses wherein the user interface is a web browser [Fig 5 item 500].

Claim 11:

Maddalozzo '060 discloses wherein the electronic content is a web page [abstract].

Claim 12:

Maddalozzo '060 discloses initializing the memory location to a default reference upon

starting the user interface [Fig 3A and col 4, lines 45-60].

Claim 13:

Maddalozzo '060 discloses:

- store a first reference to a first electronic content in a memory location, wherein the

  memory location being operable to store a single reference [Fig 1, item 106, col 5, lines

  2-8];

- display a second electronic content on a user interface, the second electronic content

  being associated with a second reference [col 7, lines 8-14];

- provide a first button [search button, Fig 5, item 514] and a second button [next/previous

  button, Fig 5, item 502] on the user interface; and display the first electronic content

  referenced by the first reference stored in the memory location on the user interface in

  response to activation of the first button [col 4, lines 17-30].

Claim 14:

Maddalozzo '060 discloses computer instructions that, when executed by a computer,

cause the computer to store a third reference to a third electronic content in the memory location

in response to activation of the second button, wherein the third electronic content being

currently displayed on the user interface [Fig 3A and col 4, lines 45-49]

Claim 15:

Maddalozzo '060 discloses wherein the user interface is a web browser [col 1, lines 17-

35]

Claim 16:

Maddalozzo '060 discloses computer instructions that, when executed by a computer, cause the computer to retrieve the first electronic content over the Internet [col 1, lines 17-35].

Claim 17:

Maddalozzo '060 discloses:

- a set trail marker icon [bookmark feature, col 4, lines 35-44 wherein response to selecting the set trail marker icon, a URL reference to a currently accessed web page is stored in a temporary memory,

- an activate trial marker icon, wherein response to selecting the activate trail marker icon the stored URL reference is used to access the web page located at the URL reference [next/previous button, Fig 5, item 502],

- a user interface for displaying the first icon and the second icon on the computer [Fig 5, 500],

Claim 18:

Maddalozzo '060 discloses wherein the activate trail marker icon is associated with a default URL reference each time the browser is started [Fig 3a and col 4, lines 45-60].

Response to Arguments

Applicant's arguments filed 2/2/2004 have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant states in the fifth paragraph on page 7 "Maddalozzo fails to disclose a web browser trail marker system as claimed by Applicant in claim 1. Maddalozzo does not disclose a

browser comprising a first button icon and a second button icon, wherein the browser, responsive to activation of the first button icon stores a reference currently accessed web page in the memory, and wherein the browser, responsive to activation of the second button icon, accesses the web page referenced by the reference stored in memory. Further, Maddalozzo does not teach or suggest a system where only a single reference is stored in memory at any point in time due to activation of a button icon. Rather Maddalozzo teaches a system where many references are stored and a user is forced to cycle through them, for example using the forward/back keys, until the desired reference is located.

First Examiner Response:

Examiner is not persuaded. Assuming that Maddalozzo stores only a single reference at any point in time, it would not be necessary to cycle through a plurality of references in order to find the desired reference. Furthermore, applicant is referred to supra office action where the elements of claim 1 are clearly identified with reference to the disclosure of Maddalozzo.

Second Applicant Argument:

Applicant states in the second paragraph on page 8 "Maddalozzo fails to disclose a system and method that allows a user to temporarily save or mark the address of a web page without contributing to the growth and unmanageability of conventional bookmark lists, and to conveniently return to the previously visited web page even after visiting a very large number of web pages. Thus, Maddalozzo suffers from the same shortcomings of the art distinguished in the background of the invention of the present application (page 2, lines 5-27).

Second Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., system and method that allows a user to temporarily save or mark the address of a web page without contributing to the growth and unmanageability of conventional bookmark lists, and to conveniently return to the previously visited web page even after visiting a very large number of web pages) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third Applicant Argument:

Applicant states in the sixth paragraph on page 8, "For similar reasons as stated above with reference to independent claim 1, Applicant believes independent claim 6 to be allowable over Maddalozzo."

Third Examiner Response:

Examiner is not convinced. Applicant is referred to supra response

Other Applicant Arguments:

On page 9 Applicant present s arguments similar to the above.

Examiner Response:

Examiner is not persuaded. Applicant is referred to supra response by examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

3/30/2004

SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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